

REMARKS

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims.

Status of the Claims

In the present Reply, claims 1 and 4-6 have been amended. Also, claim 3 has been canceled without prejudice or disclaimer of the subject matter contained therein. Thus, claims 1-12 are pending in the present application.

No new matter has been added by way of the amendment to claim 1, since the amendment is supported by the subject matter of canceled claim 3. With the cancellation of claim 3, claims 4-6 have been appropriately amended to change the dependency thereof. No new matter has been added with these amendments as well.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw the only rejection and allow the currently pending claims. Applicants' previous remarks are rendered moot in view of the new rejection that is repeated below (see paragraph 1 of the Office Action).

Issues under 35 U.S.C. § 103(a)

Claims 1-10 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Torigoshi '528 (JP 2002159528) (see paragraphs 2-4 of the Office Action). Applicants

respectfully traverse, and reconsideration and withdrawal of this rejection are respectfully requested. Generally, Applicants do not concede that a *prima facie* case of obviousness has been established.

In the present invention, the elastic members each have (a) a portion contributory to elastic extensibility and contractibility in each of the regions outside the lateral sides of the patterned sheet and (b) a portion substantially non-contributory to elastic extensibility and contractibility in the region inside the lateral sides of the patterned sheet. In other words, the elastic members also have feature (b) as recited above. Further, as can be seen from Figure 3 in Applicants' specification, the elastic members **24** in front and back portions **A** and **B**, respectively, are a continuation of elastic members **23**. However, the elastic members **24** reside in the portion **F** (the middle portion in between lateral portions **E**). In other words, the present invention has "the portion substantially non-contributory to elastic extensibility and contractibility [is] disposed between the patterned sheet and the inner sheet" (see the location of feature (b) as recited in claim 1). Also, the elastic members **24** in portion **F** of the present invention are cut or present as fragments (see Fig. 3), as also recited in claim 1 as presented herein.

In addition, the elastic members in the present invention reside in between the patterned sheet and the inner sheet. As can be seen from Figure 3, sheet **21** is the outer sheet and sheet **22** is the inner sheet. These structural features allow a picture or pictorial pattern to be clearly seen from the outside.

In contrast to the present invention and the claimed features thereof, the cited primary reference of Torigoshi '528 fails to disclose the elastic members and location thereof as instantly

claimed. As stated in paragraph 4 of the Office Action, the Examiner refers Applicants to Figures 1 and 16D of Torigoshi '528 to disclose the location of elastic members, including how such elastic member are void in the central area (see page 3, lines 1-6 of the Office Action). However, Torigoshi '528 still fails to disclose "a patterned sheet having a pattern is disposed between the outer sheet and the inner sheet" as instantly claimed. In other words, Torigoshi '528 fails to describe or depict in its Figures 1 and 16D the actual location of its patterned sheet (e.g., on top of the outer sheet; etc.). Thus, Torigoshi '528 does not disclose all instantly claimed features.

In addition, Applicants note that elastic members in the present invention reside in between the patterned sheet and the inner sheet. Further, as can be seen from Figure 3, sheet 21 is the outer sheet and sheet 22 is the inner sheet. These structural features allow a picture or pictorial pattern to be clearly seen from the outside. Such features are not disclosed in Torigoshi '528. It is not even clear or clearly disclosed in Torigoshi '528 if its pictorial pattern (e.g., a picture of a dog) is clearly seen from an outside point of view.

Accordingly, Applicants respectfully submit that the cited modification of Torigoshi '528 still fails to disclose all instantly claimed features and a *prima facie* case of obviousness has not been established. This is because U.S. case law squarely holds that a proper obviousness inquiry requires consideration of three factors: (1) the prior art reference (or references when combined) must teach or suggest all the claim limitations; (2) whether or not the prior art would have taught, motivated, or suggested to those of ordinary skill in the art that they should make the claimed invention (or practice the invention in case of a claimed method or process); and (3) whether the prior art establishes that in making the claimed invention (or practicing the invention in case of a

claimed method or process), there would have been a reasonable expectation of success. *See In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); *see also In re Kotzab*, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000); *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). In this regard, not even the initial requirement of disclosure of all claimed features has been satisfied. For instance, the cited modification of Torigoshi '528 does not disclose that a patterned sheet having a pattern is disposed between the outer sheet and the inner sheet as instantly claimed. Thus, this rejection under § 103(a) has been overcome.

Applicants add that the requisite motivation as well as the reasonable expectation of success are lacking.

With regard to the required level of motivation, the location of the portion that is substantially non-contributory to elastic extensibility and contractibility aids in bringing about a pictorial pattern clearly seen from the outside of the absorbent article. Such a feature or description is missing in the cited Torigoshi '528 reference.

With regard to the requisite reasonable expectation of success, Torigoshi '528 merely discloses a picture on its diaper in Figure 1. Therefore, Applicants respectfully submit that such a generic description does not lead one of ordinary skill in the art to experiment enough such that the claimed invention could be achieved. In this regard, Applicants respectfully submit that it is not *prima facie* obvious to modify a reference unless the references suggest an advantage to be gained from the modification. *See In re Sernaker*, 217 USPQ 1, 6 (Fed. Cir. 1983). That suggestion is missing in Torigoshi '528. Thus, Applicants respectfully submit that the required level of reasonable expectation of success is lacking.

Regarding the lack of disclosure in Torigoshi '528 for the claimed total transmittance value as recited in pending claim 2, Applicants respectfully traverse the Examiner's position since this feature is a not matter of optimization. The Examiner has not provided any scientific or technical evidence to show that this feature of, e.g., pending claim 2, is a matter of routine skill in the art. Applicants also traverse the conclusions of optimization and the application of the *In re Boesch* decision as stated at page 3 of the Office Action. This is because: "The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention on any ground is always upon the examiner." *Ex parte Parks*, 30 USPQ2d 1234, 1236 (citing *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992)); *see also In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984). Here, since no literature or evidence has been provided to show that, e.g., opacity is a matter of optimization, the burden has not shifted back to Applicants to prove otherwise.

Unexpected Results for the Present Invention

Applicants respectfully submit that the present invention has achieved unexpected results, whereby such results rebut any asserted *prima facie* case of obviousness (whether based on Sauer '639, Buell '458 or any other reference or combinations thereof). *See In re Corkill*, 711 F.2d 1496, 226 USPQ 1005 (Fed. Cir. 1985); *see also In re Papesch*, 315 F.2d 381, 137 USP 43 (CCPA 1963); *In re Wiechert*, 370 F.2d 927, 152 USPQ 247 (CCPA 1967). As stated in M.P.E.P. § 2144.09 (see section entitled "*Prima Facie* Case Rebuttable By Evidence of Superior or Unexpected Results"), any rejection under 35 U.S.C. § 103(a) may be rebutted by a sufficient showing of unexpected results for the present invention.

Here, by virtue of the nature of the claimed limitation of “the elastic members have a portion substantially non-contributory to elastic extensibility and contractibility in the region inside the lateral sides of the patterned sheet,” the present invention has achieved unexpected results. Specifically, such a feature enables the claimed absorbent articles to be produced at high speed with stability, which is an unexpected improvement in the state of the art. In other words, when the absorbent articles are manufactured at high speed, this claimed limitation is especially useful in that the absorbents articles are made quickly and with stability.

Therefore, Applicants respectfully submit that the present invention has achieved unexpected results, whereby such results rebut any asserted *prima facie* case of obviousness. Reconsideration and withdrawal of this rejection are respectfully requested for this additional distinction.

Summary of Applicants’ Position

Based on the above, Applicants respectfully submit that a *prima facie* case of obviousness has not been established (e.g., no disclosure of all claimed features; requisite reasonable expectation of success is missing). In addition, or alternatively, the present invention has achieved unexpected results that rebut any rejection made under § 103(a). Accordingly, Applicants respectfully request reconsideration, withdrawal of this rejection and allowance of the currently pending claims.

Application No. 10/784,197
Art Unit 3761
Reply to Office Action of April 21, 2006

Docket No.: 0445-0347P

Conclusion

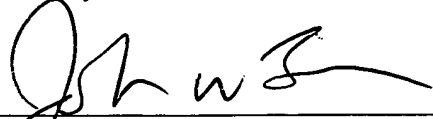
A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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